

**Amendment and Response UNDER 37 C.F.R. 1.116**

Applicant: Stuart Asakawa

Serial No.: 09/905,623

Filed: 7/13/2001

Docket No.: 10011919-1/H301.426.101

Title: PRINT FOR PAY PRINTER

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**REMARKS**

The following remarks are made in response to the Final Office Action mailed June 2, 2004, in which claims 1-23 were rejected. With this Response, claims 1, 9 and 19 have been amended, and claims 21-23 have been cancelled. Claims 1-20 remain pending in the application and are presented for reconsideration and allowance.

**Claim Rejections under 35 U.S.C. § 103**

Claims 1, 4-6, 9-12, 15-17 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Farros et al. (U.S. Patent No. 5,930,810) in view of Hayashi et al. (U.S. Patent No. 6,375,297).

Farros is alleged to teach the invention as presented in independent claims 1, 9 and 19, including printer resources "such as sizes, colors and font". However, Farros is acknowledged as failing to clearly disclose that the printer resources are operational resources, including a selected printer resolution and a selected printer throughput speed. Hayashi is cited as teaching additional printer resources not taught by Farros, including print quality modes and printing speed, that may be selected by the user. The Examiner therefore finds it would have been obvious to one of ordinary skill in the art to integrate Farros and Hayashi to arrive at the claimed invention.

The Examiner also presents a variety of additional 35 U.S.C. § 103(a) rejections, and in each case relies on the above combination of Farros and Hayashi: claims 2 and 13 stand rejected as obvious over Farros in view of Hayashi, and further in view of Pierce (U.S. Patent No. 6,202,058); claim 3 stands rejected as obvious over Farros in view of Hayashi, and Pierce, and further in view of Narukawa (U.S. Patent No. 6,281,978); claims 7, 8 and 18 stand rejected as obvious over Farros in view of Hayashi, and further in view of Nocker (U.S. Patent No. 6,236,486); claims 14 and 20 stand rejected as obvious over Farros in view of Hayashi, and further in view of Freeman (U.S. Patent No. 6,134,557); and claims 21-23 stand rejected as obvious over Farros in view of Hayashi, and further in view of Maekawa (U.S. Patent No. 5,386,271).

Independent claims 1, 9 and 19 have been amended to incorporate the subject matter of dependent claims 21, 22 and 23, respectively. Each of amended independent claims 1, 9

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and 19 now specifies that the payment transaction includes a charge calculated as a function of the resource request.

As noted above, claims 21-23 stand rejected as being obvious over Farros in view of Hayashi, and further in view of Maekawa (U.S. Patent No. 5,386,271). The Examiner's rejection is respectfully traversed. In particular, the combination of Farros, Hayashi and Maekawa fails to teach, disclose or make obvious the subject matter of amended independent claims 1, 9 and 19.

Farros sells products, such as business cards, envelopes and letterhead, which may be personalized by a user by selecting and arranging predefined elements, such as graphics, sizes, fonts, colors and other attributes, of predefined forms. (Column 2, lines 50-65). The printing or production resources of Farros are available downstream from the product selection, and the operational resources of the printer are not selected or specified by the user. Farros does mention a charge for the printed products, but provides no details whatsoever regarding calculation of an amount to be charged to the user. In particular, Farros only suggests a charge for the printed product generally, and fails to teach or suggest a charge calculated as a function of the request for the use or right of use of a "printer operational resource". The Examiner acknowledges in paragraph 7 of the Office Action that "Farros fails to teach that the payment transaction includes a charge calculated as a function of the resource request."

While Hayashi teaches that a user may select printer resources including print quality modes and printing speed, Hayashi fails to remedy the above-noted defect of Farros. Particularly, Hayashi does not mention or disclose a charge for printing services, and therefore cannot disclose a charge calculated as a function of the request for the use or right of use of a "printer operational resource". Therefore, the combination of Farros and Hayashi still fails to disclose, suggest or make obvious that the payment transaction includes a charge calculated as a function of the resource request.

To remedy the deficiency of Farros and Hayashi, the Examiner cites Maekawa as teaching that a charge is calculated on the basis of a count value of total counter. The Examiner alleges that it would have been obvious to one of ordinary skill in the art to integrate the teachings of Maekawa into the teachings of Farros "in order for the printer to request the user the appropriate charge for the use of the printer according to the resources

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and number of pages the user printed from the printer, and such modification provides a more accurate charge and details of the use of the printer.”

Despite the Examiners assertions, Maekawa also fails to remedy the deficiency of Farros and Hayashi. In particular, Maekawa teaches that in the copy machine, a charge is calculated based on the values of a total counter indicating the number of pages discharged and a paper size counter indicating the number of pages for each paper size. (Column 4, lines 23-28). Thus, the charge is not based on the use or right of use of operational resources of the copier. Accordingly, Maekawa, like Farros, fails to teach or suggest that the payment transaction includes a charge calculated as a function of the resource request. Therefore, the combination of Farros and Maekawa, or the combination of Farros, Hayashi and Maekawa still fails to disclose, suggest or make obvious that the payment transaction includes a charge calculated as a function of the resource request.

As set forth above, none of Farros, Hayashi and Maekawa, either alone or in combination, show, teach or suggest that the payment transaction includes a charge calculated as a function of the resource request. Accordingly, for at least this reason, amended independent claims 1, 9 and 19 are not obvious over Farros in view of Hayashi, and further in view of Maekawa, and are thus in allowable condition. Withdrawal of the rejection of independent claims 1, 9 and 19 under 35 U.S.C. § 103(a) is respectfully requested.

Each of dependent claims 2-8, 10-18 and 20 depend from one of amended independent claims 1, 9 and 19, which are in allowable condition as set forth above. Therefore, dependent claims 2-8, 10-18 and 20 are also in allowable condition, and withdrawal of the rejections of those claims under 35 U.S.C. § 103(a) is respectfully requested.

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**CONCLUSION**

In light of the above, Applicant believes independent claims 1, 9 and 19, and the claims depending therefrom, are in condition for allowance. Therefore, reconsideration and withdrawal of the outstanding rejections is respectfully requested.

No fees are required under 37 C.F.R. 1.16(b)(c). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 08-2025.

Any inquiry regarding this Amendment and Response should be directed to either Matthew B. McNutt at Telephone No. (512) 231-0531, Facsimile No. (512) 231-0540 or Robert D. Wassen at Telephone No. (360) 212-2338, Facsimile No. (360) 212-3060. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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**CERTIFICATE UNDER 37 C.F.R. 1.8:** The undersigned hereby certifies that this paper or papers, as described herein, are being facsimile transmitted to the United States Patent and Trademark Office. Fax No. (703) 872-9306 on this 7<sup>th</sup> day of July, 2004.

By   
Name: Matthew B. McNutt